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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,606	08/24/2001	Masuyo Horiguchi	PNDF-01114	8991
30743	7590	05/07/2004		
WHITHAM, CURTIS & CHRISTOFFERSON, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190			EXAMINER SING, SIMON P	
			ART UNIT 2645	PAPER NUMBER <i>[Handwritten mark]</i>
DATE MAILED: 05/07/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/935,606

Applicant(s)

HORIGUCHI, MASUYO

Examiner

Simon Sing

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2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 7 define a non-communicative mode in the preamble as: "a non-communicative mode in which said portable telephone functions for purposes unrelated to its intrinsic function". An intrinsic function is a function which comes with (build-in) said portable telephone, such as games, calculator and phonebook, etc. If a non-communication mode is unrelated to build-in functions of said portable telephone, then there would be no function to perform at all.

Appropriate correction is required (Examiner suggests changing the "intrinsic function" to "telephone function").

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

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said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atsushi Japanese Patent publication Number 11-308163 in view of Korycan US 5,950,139.

2.1 Regarding claim 1, Atsushi discloses a portable telephone in figures 1 and 2, Atsushi teaches a stop key 6d, which when pressed, a central processing unit 4 disconnects DC power to radio units 2 and 3, disabling its telephone function, and a non-communicative mode indicator (figure 5) appears on display unit 7 (figure 4) (section 0018-036). Atsushi teaches that central processing unit 4 displays the non-communicative mode indication in the display unit, but fails to teach lighting a lamp in the non-communicative mode.

However, Korycan discloses a portable telephone in figures 1-5. Korycan teaches that an indicators, such as a signal strength indicator, normally appears in a display unit can be replaced by LED lamps (column 1, lines 11-18, 57-67; column 2, lines 16-23).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Atsushi's reference with the teaching of Korycan, so that a lamp would have replaced the non-communicative indicator in the display unit 7, because replacing the non-communicative indicator in a display with a LED lamp would have been a design choice, since it die not alter the functionality of Atsushi's.

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2.2 Regarding claim 2, as discussed in claim 1, Atsushi teaches a stop key 6d for disabling radio units 2 and 3.

2.3 Regarding claim 3, as discussed in claim 1, the lamp lights up continuously in the non-communicative mode.

2.4 Regarding claim 4, as discussed in claim 1, the modified Atsushi reference places the indicator visible to other persons besides the user of the portable telephone.

2.5 Regarding claim 5, as discussed in claim 1, the indicator is a LED.

3. Claims 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atsushi Japanese Patent publication Number 11-308163 in view of Korycan US 5,950,139 and further in view of Nonogaki US 6,625,478.

3.1 Regarding claim 6, the Atsushi's reference, modified by Korycan, teaches disabling the portable telephone's radio unit, but fails to teach urging a user to choose either a communicative mode or non-communicative mode.

However, Nonogaki discloses a wireless telephone in figure 1. The wireless telephone has three operation modes, AV mode (non-communicative mode), telephone/AV mode and telephone mode (communicative mode)

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(Abstract; column 6, lines 1-13). Nonogaki teaches that in a stand-by state, power to all modules (VA module 200, telephone module 300 and common module (including display) 400) are off except power management controller 101 (column 8, lines 39-49), and when power switch K1 is pressed, the device is turned-on and displays an operation mode, urging a user to confirm by pressing power switch K2, the user may press K2 to select the operation mode displayed, or press K1 again to change the operation mode (column 9, lines 1-22, 41-59). Nonogaki also teaches warning a user when a telephone mode (or telephone/AV mode) is waiting to be selected (column 9, lines 41-59).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Atsushi's reference, which was modified by Korycan, with the teaching of Nonogaki, so that a display would have urged a user to decide an operation mode, such as communicative mode or a non-communicative mode, because such a modification would have provide a warning message to a user to turn off the radio unit in case said portable telephone was power-up in a restricted area.

3.2 Regarding claim 7, Atsushi discloses a portable telephone in figures 1 and 2, Atsushi teaches a stop key 6d, which when pressed, a central processing unit 4 disconnects DC power to radio units 2 and 3, disabling its telephone function, and a non-communicative mode indicator (figure 5) appears on display unit 7 (figure 4) (section 0018-036). Atsushi teaches that central processing unit 4 displays the non-communicative mode indication in the display unit, but fails to

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teach lighting a lamp in the non-communicative mode and urging a user to choose either mode when power up.

However, Korycan discloses a portable telephone in figures 1-5. Korycan teaches that an indicators, such as a signal strength indicator, normally appears in a display unit can be replaced by LED lamps (column 1, lines 11-18, 57-67; column 2, lines 16-23).

However, Nonogaki discloses a wireless telephone in figure 1. The wireless telephone has three operation modes, AV mode (non-communicative mode), telephone/AV mode and telephone mode (communicative mode) (Abstract; column 6, lines 1-13). Nonogaki teaches that in a stand-by state, power to all modules (VA module 200, telephone module 300 and common module (including display) 400) are off except power management controller 101 (column 8, lines 39-49), and when power switch K1 is pressed, the device is turned-on and displays an operation mode, urging a user to confirm by pressing power switch K2, the user may press K2 to select the operation mode displayed, or press K1 again to change the operation mode (column 9, lines 1-22, 41-59). Nonogaki also teaches displaying a warning message when a telephone mode (or telephone/AV mode) is selected (column 9, lines 41-59).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Atsushi's reference with the teachings of Korycan and Nonogaki, so that a lamp would have replaced the non-communicative indicator in the display unit 7, and display unit 7 would have urged a user to decide an operation mode, such as a communicative mode or a

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non-communicative mode. Since replacing the non-communicative indicator with a LED lamp not alter the functionality of Atsushi's and thus would have been a design choice, and such modification would have provide a warning message to a user to turn off the radio unit in case said portable telephone was power-up in a restricted area.

3.3 Regarding claim 8, the Atsushi's teaches using a switch 6d for disable the radio units 2 and 3. Replacing switch 6d with a touch screen switch would have been a design choice since it did not change the functionality of the modified Atsuahi's portable telephone.

3.4 Regarding claim 9, as discussed in claim 7, the lamp lights up continuously in the non-communicative mode.

3.5 Regarding claim 10, as discussed in claim 7, the modified Atsushi reference places the indicator visible to other persons besides the user of the portable telephone.

3.6 Regarding claim 11, as discussed in claim 7, the indicator is a LED.

3.7 Regarding claim 12, a portable telephone inherently has key-tone on/off feature selectable through a menu.

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Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Sprigg et al US 6,453,182 discloses a cellular telephone with an alarm clock and airplane mode in that power to modem and transceiver is off.

b) Wartz et al. US 6,243,447 discloses a portable terminal with telephone or scanner function.

5. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is (703) 305-3221. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.


S.S.
04/19/2004

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